

ESTTA Tracking number: **ESTTA576024**

Filing date: **12/11/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92057518
Party	Defendant Empire IP Holdings LLC
Correspondence Address	STEVEN N FOX ESQ 62 S MAIN ST SHAROM, MA 02067 UNITED STATES sfox@foxpatent.com
Submission	Motion to Amend/Amended Answer or Counterclaim
Filer's Name	Steven N. Fox
Filer's e-mail	sfox@foxpatent.com, snf33237@gmail.com
Signature	/Steven N. Fox/
Date	12/11/2013
Attachments	First Amended Answer 12-11-2013.pdf(63717 bytes )

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

The George Nelson Foundation,

Petitioner,

v.

Empire IP Holdings LLC,

Registrant.

Cancellation No. 92057518

U.S. Reg. No. 3,463,818

Mark: GEORGE NELSON BY VERICHRON

Date of Registration: July 8, 2008

FIRST AMENDED ANSWER

The Registrant, Empire IP Holdings LLC, answers the First Amended Petition to Cancel filed by the Petitioner, The George Nelson Foundation, as follows:

1. Registrant is without sufficient knowledge to admit or deny the allegations set forth in Paragraph 1 of the First Amended Petition to Cancel and therefore denies the same.
2. Registrant is without sufficient knowledge to admit or deny the allegations set forth in Paragraph 2 of the First Amended Petition to Cancel and therefore denies the same.
3. Registrant is without sufficient knowledge to admit or deny the allegations set forth in Paragraph 3 of the First Amended Petition to Cancel and therefore denies the same.

4. Registrant is without sufficient knowledge to admit or deny the allegations set forth in Paragraph 4 of the First Amended Petition to Cancel and therefore denies the same.
5. Registrant denies the allegations set forth in Paragraph 5 of the First Amended Petition to Cancel.
6. Registrant is without sufficient knowledge to admit or deny the allegations set forth in Paragraph 6 of the First Amended Petition to Cancel and therefore denies the same.
7. Registrant is without sufficient knowledge to admit or deny the allegations set forth in Paragraph 7 of the First Amended Petition to Cancel and therefore denies the same.
8. Registrant admits that at the time Registrant's predecessor-in-interest applied to register the mark GEORGE NELSON BY VERICHRON for clocks, he read articles about the late George Nelson. Registrant is without sufficient knowledge to admit or deny the remainder of the allegations set forth in Paragraph 8 of the First Amended Petition to Cancel and therefore denies the same.
9. Registrant admits that Registrant's licensee(s) sold and continues to sell clocks under its registered mark GEORGE NELSON BY VERICHRON. Registrant is without sufficient knowledge to admit or deny the remainder of the allegations set forth in Paragraph 9 of the First Amended Petition to Cancel and therefore denies the same.

10. Registrant admits that Registrant, nor its predecessor-in-interest, never had any affiliation with Petitioner, the late George Nelson, or Ms. Nelson. Registrant is without sufficient knowledge to admit or deny the remainder of the allegations set forth in Paragraph 10 of the First Amended Petition to Cancel and therefore denies the same.
11. Registrant re-alleges its Answers to Paragraphs 1-10 of the petition to Cancel.
12. Paragraph 12 of the Petition to Cancel alleges questions of law that do not require an answer. Any factual allegations are denied by Registrant.
13. Registrant admits the allegations set forth in Paragraph 13 of the First Amended Petition to Cancel.
14. Registrant denies the allegations set forth in Paragraph 14 of the First Amended Petition to Cancel.
15. Registrant admits the allegations set forth in Paragraph 15 of the First Amended Petition to Cancel.
16. Registrant denies the allegations set forth in Paragraph 16 of the First Amended Petition to Cancel.
17. Registrant re-alleges its Answers to Paragraphs 1-16 of the First Amended Petition to Cancel.
18. Paragraph 18 of the Petition to Cancel alleges questions of law that do not require an answer. Any factual allegations are denied by Registrant.
19. Registrant is without sufficient knowledge to admit or deny the allegations set forth in Paragraph 19 of the First Amended Petition to Cancel and therefore denies the same.

20. Registrant denies the allegations set forth in Paragraph 20 of the Petition to Cancel.
21. Registrant is without sufficient knowledge to admit or deny the allegations set forth in Paragraph 21 of the First Amended Petition to Cancel and therefore denies the same.
22. Registrant denies the allegations set forth in Paragraph 22 of the First Amended Petition to Cancel.
23. Registrant re-alleges its Answers to Paragraphs 1-22 of the First Amended Petition to Cancel.
24. Paragraph 24 of the Petition to Cancel alleges questions of law that do not require an answer. Any factual allegations are denied by Registrant.
25. Registrant denies the allegations set forth in Paragraph 25 the First Amended Petition to Cancel.
26. Registrant denies the allegations set forth in Paragraph 26 the First Amended Petition to Cancel.
27. Registrant re-alleges its Answers to Paragraphs 1-26 of the First Amended Petition to Cancel.
28. Paragraph 28 of the Petition to Cancel alleges questions of law that do not require an answer. Any factual allegations are denied by Registrant.
29. Paragraph 29 of the Petition to Cancel alleges questions of law that do not require an answer. Any factual allegations are denied.
30. Registrant denies the allegations set forth in Paragraph 30 of the Petition to Cancel.

31. Registrant admits that at the time Registrant's predecessor-in-interest, Wen Chen Wu, filed the application for mark GEORGE NELSON BY VERICHRON, he read articles about the late George Nelson. Registrant is without sufficient knowledge to admit or deny the remainder of the allegations set forth in Paragraph 31 of the First Amended Petition to Cancel and therefore denies the same.

32. Registrant admits that Registrant's authorized representative signed a declaration section of a trademark application for the mark GEORGE NELSON BY VERICHRON. Registrant denies the remainder of the allegations set forth in Paragraph 32 of the First Amended Petition to Cancel.

33. Registrant denies the allegations set forth in Paragraph 33 of the First Amended Petition to Cancel.

34. Registrant denies the allegations set forth in Paragraph 34 of the First Amended Petition to Cancel.

35. Registrant denies the allegations set forth in Paragraph 35 of the First Amended Petition to Cancel.

### AFFIRMATIVE DEFENSES

1. Petitioner's claims are barred by the doctrine of laches in that Petitioner waited about five (5) years to file the Petition to Cancel from the date of constructive notice and Registrant has and continues to be prejudiced as a result of such delay, and confusion is not inevitable.
2. Petitioner's claims are barred by the doctrine of unclean hands in that Petitioner has policed and/or enforced its purported trademark rights in an unconscionable and anti-competitive manner. Petitioner had constructive notice of U.S. Reg. No. 3,463,818 for the mark GEORGE NELSON BY VERICHRON for about five (5) years before filing the Petition to Cancel on the last day of the five (5) year statutory period. Upon information and belief, Petitioner had actual knowledge of U.S. Reg. No. 3,463,818 and Registrant's use of the mark GEORGE NELSON BY VERICHRON more than three (3) years prior to filing the Petition to Cancel and never provided notice to Registrant within any reasonable time upon learning of Registrant's use of the mark GEORGE NELSON BY VERICHRON. Petitioner's actions and the filing of the Petition to Cancel is further harassment by Petitioner to force Registrant into stopping use of its registered mark GEORGE NELSON BY VERICHRON, all causing irreparable and monetary harm to Registrant. Petitioner does not come to this cancellation proceeding with clean hands.

WHEREFORE, Registrant respectfully requests the First Amended Petition to  
Cancel be dismissed with prejudice.

Respectfully submitted,

Empire IP Holdings LLC

By its Attorney,

Dated: 12-11-2013

/Steven N. Fox/  
Steven N. Fox, Esq.  
62 South Main Street  
Sharon, MA 02067  
(781) 821-8920  
sfox@foxpatent.com

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on December 11, 2013, a true copy of this paper has been served upon counsel for the Petitioner at their e-mail addresses of record (by agreement), namely, to carolyn.passen@kattenlaw.com, william.dorsey@kattenlaw.com, and julia.kasper@kattenlaw.com.

/Steven N. Fox/  
Steven N. Fox